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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,815	10/24/2003	Gene DiPoto	1291.1143101	1092
28075 7590 03/19/2009 CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				
EXAMINER				
RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
03/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/693,815

Applicant(s)

DIPOTO, GENE

Examiner

Anu Ramana

Art Unit

3775

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 18, 23-28, 32, 33, 35 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 19-22, 29-31, 34 and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman et al. (US 6,074,390) in view of Bonutti (US 5,295,994).

Zucherman et al. disclose a method of treating adjacent vertebrae in a spine of a patient including the steps of: inserting an access device or cannula through a minimally invasive incision in the skin of a patient; expanding the access device by placing a plurality of cannula wherein the first smaller cannula is followed by a successively larger cannula, i.e., progressively expanding a cannula; inserting an implant made of an elastic material through the largest cannula; and utilizing fasteners to fasten the implant to the adjacent vertebrae (Figs. 39 and 40, col. 1, lines 26-49, col. 4, lines 18-28, col. 9, lines 13-67 and col. 10, lines 1-14).

Regarding claims 30 and 36, Zucherman et al. disclose an implant in the form of a spring (Fig. 59 and col. 12, lines 23-31).

Zucherman et al. disclose all elements of Applicant's claimed invention except for a single access device or cannula having an expandable distal end.

Bonutti teaches the equivalence of progressively expanding a cannula or the use of a cannula stretched radially outwardly for progressive stretching of an incision in skin or subsurface tissue. Bonutti also discloses a type of cannula that is stretched radially outwardly at a distal end thereof (Fig. 16, col. 2, lines 7-35).

The substitution of one known type of cannula (cannula stretched radially outwardly, as taught by Bonutti) for another known cannula (progressively

expanding cannula as disclosed by Zucherman et al.) would have been obvious to one of ordinary skill in the art at the time the invention was made since this amounts to simple substitution of one known type of a cannula for another and would have yielded predictable results, namely, progressive stretching of subsurface tissue with a small incision.

The claimed method steps are rendered obvious by the above discussion.

Response to Arguments

Applicant's arguments filed on November 7, 2008 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground of rejection has been made over Zucherman et al. (US 6,074,390) in view of Bonutti (US 5,295,994), as discussed in this action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3775

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

March 16, 2009

/Anu Ramana/

Primary Examiner, Art Unit 3775